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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,932	11/13/2003	Chunqiang Tang	200308654-1	6564

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EXAMINER

PONIKIEWSKI, TOMASZ

ART UNIT	PAPER NUMBER
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2165

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/705,932	TANG ET AL.	
	Examiner	Art Unit	
	Tomasz Ponikiewski	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/24/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 14-24 is/are rejected.
- 7) ☒ Claim(s) 5-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/24/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-24 are pending.
2. The drawings of the invention have been received and accepted.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 14, and 18-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 14 do not specify an output at the end of the claim. No output is presented or stored for subsequent use. It is unclear what the end result of the steps of the claims is. The output needs to be useful, and concrete. Identifying or determining does not result in the useful and concrete result.

Claims 18-21 are not limited to tangible embodiments. In view of applicant's disclosure, specification paragraph 98, lines 8-9, the medium is not limited to tangible embodiments. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a signal-bearing media or other intangible or non-

Art Unit: 2165

functional media. For this specification, signal-bearing media may not be statutory as it may include medium that is not statutory. Claims should be amended to recite "computer storage medium".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, and 12-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Mohan et al. (US 2005/0108368 A1)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As per claims 1, 14 and 18 Mohan et al. is directed to executing a search in a peer-to-peer system, the method comprising:

Art Unit: 2165

receiving a query at a destination node (page 2, paragraph 0021, lines 1-3);
receiving samples from a first set of nodes proximally located to the destination node in an overlay network for the peer-to-peer system, the samples associated with information stored at the proximally located nodes (page 5, paragraph 0052, lines 2-6);
and

identifying, based on the samples received from the first set of nodes, a first node of the first set of nodes likely storing information associated with objects stored in the peer-to-peer system that are relevant to the query (page 2, paragraph 0022, second column, lines 4-5).

As per claims 2, 15 and 19 Mohan et al. is directed further comprising:
comparing the query to information stored in the first node; wherein the information stored in the first node is associated with objects stored in the peer-to-peer network (page 2, paragraph 0022, second column, lines 6-7); and
generating search results including information stored in the first node associated with objects relevant to the query based on the comparison of the query to the information stored in the first node (page 5, paragraph 0053, lines 7-9).

As per claims 3, 16 and 20 Mohan et al. is directed to further comprising:
determining whether a quit threshold has been reached (page 5, paragraph 0059, lines 1-3);

transmitting the search results to an initiator of the query in response to the quit threshold being reached (page 5, paragraph 0060, lines 4-6); and

performing the following steps in response to the quit threshold not being reached:

- identifying a second node likely storing information associated with objects stored in the peer-to-peer network that are relevant to the query based on samples received from a second set of nodes including the second node, wherein the second set of nodes are nodes proximally located to the first node in the overlay network (page 5, paragraph 0058); and

- adding information stored in the second node to the search results; the added information being associated with objects that are relevant to the query (page 5, paragraph 0060, lines 4-6).

As per claims 4, 17 and 21 Mohan et al. is directed to wherein the quit threshold is associated with at least one of hops in the overlay network and whether the search results can be improved by adding information to the search results from the second node (page 5, paragraph 0062, lines 4-8).

As per claim 12 Mohan et al. is directed to wherein the first set of nodes are neighbor nodes to the destination node in the overlay network (page 5, paragraph 0052, lines 2-6).

Art Unit: 2165

As per claim 13 Mohan et al. is directed to wherein the second set of nodes are neighbor nodes to the first node in the overlay network (page 5, paragraph 0052, lines 2-6).

As per claim 22 Mohan et al. is directed to a peer-to-peer system comprising:
a plurality of nodes in the system operating as a search engine operable to execute a query received by the search engine (page 1, paragraph 0008, lines 1-3);
an overlay network implemented by the plurality of nodes (page 5, paragraph 0052, lines 2-6);

a plurality of indices stored at the plurality of nodes, each index including at least one semantic vector for an object (figure 3; page 2, paragraph 0018, lines 1-2, wherein "semantic vector" could mean "bit-vector"; page 4, paragraph 0048, lines 35-8);

wherein a first node in the search engine is operable to receive samples from nodes proximally located to the first node in the overlay network, the first node utilizing the samples to identify an index of one of the other nodes to search in response to receiving the query (page 2, paragraph 0022).

As per claim 23 Mohan et al. is directed to wherein similar semantic vectors are stored at nodes proximally located in the overlay network (page 2, paragraph 0022, wherein Bloom-filter can be represented by a vector).

Art Unit: 2165

As per claim 24 Mohan et al. is directed to wherein the first node is located in a region in the overlay network and the first node is operable to store indices from nodes in the region, such that the first node is operable to search a plurality of indices likely to include information relevant to the query without forwarding the query to other nodes in the region (page 4, paragraph 0040).

Allowable Subject Matter

7. Claims 5-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 11/24/2006 have been fully considered but they are not persuasive.

As to the rejections under 35 USC 101 applicant amendments are not deemed persuasive.

Claims 1 and 14 do not produce real word results. Identifying and determining something does not provide useful, concrete and tangible results.

Amendments to claims 18-21 do not remove the signals from inclusion in the claim. Signals are non-statutory subject matter and cannot be included in the claim. The applicant needs to clearly differentiate between signals and storage media.

Response to Amendment

8. The affidavit filed on November 24 2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Mohan et al. (US 2005/0108368 A1) reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Mohan et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. Each claim needs to be clearly correlated to sections (line number, column number) in the exhibit.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Mohan et al. reference to either a constructive reduction to practice or an actual reduction to practice. MPEP 2138.06 Diligence

Art Unit: 2165

required in preparing and filing patent application states, that six days to execute and file application is acceptable. The exhibits C and D show a time gap that is longer.

Since the petition under 37 CFR 1.47 was not filed or granted, all inventors need to sign the affidavit.

The examiner also notices that the supporting document lists three authors, while the listed inventors are only two of those authors. At this time it cannot be determined what contributions the third author made.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

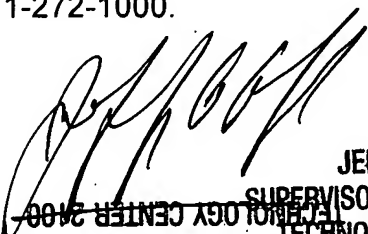

Art Unit: 2165

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tomasz Ponikiewski whose telephone number is (571)272-1721. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (571)272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tomasz Ponikiewski
February 6, 2007


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